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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,720	01/10/2007	Patrick Moireau	294251US0PCT	1968
22850	7590	12/30/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.			GRAY, JILL M	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	
			1794	
			NOTIFICATION DATE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/588,720	Applicant(s) MOIREAU ET AL.	
	Examiner Jill Gray	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/08/2006;07/11/2007;08/29/2008</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

3. The abstract of the disclosure is objected to because it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claim 9 is objected to because of the following informalities: In claim 9, line 1, "composition" is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 9-10, 12-13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al, 4,090,984 (Lin).

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Regarding Independent claims 1 and 6

Lin discloses a glass strand or glass strand structure coated with an electrically conducting coating composition. Said composition comprises about 40 to about 80% by wt of a film-forming agent, 1-5% by wt of a surfactant, and 20 to 40% by wt of carbon black (electrically conducting particles). See entire document, and for example column 1, lines 60-63, column 2, lines 32-35, and column 3, lines 15-18.

Regarding dependent claims 2-6, 10, 12-13 and 15-17

As to claims 2-3, Lin further discloses that the film-forming agent can be a polyacrylic polymer, such as polyacrylate. See column 1, lines 39-59.

As to claim 4, Lin further discloses that his surfactant can be nonylphenoxypolyethyleneoxy ethanol. See column 3, lines 10-15.

As to claim 5, Lin discloses that the conducting particles can be carbon black. See column 2, lines 3-5.

As to claim 6, Lin discloses a particle size that does not exceed 250µm. See column 2, line 20.

As to claims 10 and 16, the prior art composition is the same as the composition of the present claims. Products of the same composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562, F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

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When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicants has the burden of showing that they are not.

In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Accordingly, the examiner has reason to believe that the composition of the prior art exhibits a viscosity that is essentially as claimed by applicants in the absence of factual evidence to the contrary.

As to claim 12, Lin discloses a process for preparing the glass strand or structure that comprises coating a glass strand or structure with said composition and heating at a temperature sufficient to remove the water. See column Example II. The dried coating is inherently strengthened.

As to claim 13, Lin discloses that the glass strand can be coated by a dipping process. This teaching anticipates the required coating by immersion in a bath of the composition. See column 3, lines 47-49.

As to claim 15, Lin discloses that the glass strand can be formed into an assemblage of intertwined strands. See column 3, lines 45-55.

As to claim 17, Lin discloses that the coated glass roving can be overcoated with a matrix material. See column 3, lines 45-46. This teaching anticipates the requirement of present claim 17.

Therefore, the teachings of Lin anticipate the invention as claimed in present claims 1-6, 9-10, 12-13, and 15-17.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 7-8, 11, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al., 4,090,984 (Lin) as applied above to claims 1-6, 9-10, 12-13, and 15-16.

Regarding claims 7-8 and 11

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Lin is as set forth above but does not teach the specific aspect ratio and particle shape.

In this regard, it is the examiner's position that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimension, would not perform differently than the prior art device, the claimed device was not patentable distinct from the prior art device. See MPEP 2144.04. Accordingly, the requirements of present claims 7-8 and 11 are not construed to be a matter of invention in the absence of factual evidence to the contrary.

Regarding claim 14

Lin is as set forth above but does not teach the specific temperature range.

In this regard, it is the examiner's position that normally a change in temperature would be an unpatentable modification, unless these changes impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different from the prior art. It is not evident on this record that the present claimed temperature range is critical. Moreover, Lin discloses the general conditions of the process of 12. Hence, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233 (CCPA 1955).

Regarding claim 18

Lin teaches a matrix material overbraid of glass fibers strands, but does not teach a thermoplastic or thermosetting polymer or cementing material.

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In this regard, it would have been obvious to the skilled artisan at the time the invention was made to modify the matrix overbraid by using other high strength, high heat resistant fibrous material such as ultra high molecular weight polyethylene or "KEVLAR" with the reasonable expectation of success of producing an electrical cable having high heat resistance.

Therefore the teachings of Lin would have rendered obvious the invention as claimed in present claims 7-8, 11, 14 and 18.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524.

The examiner can normally be reached on M-Th and alternate Fridays 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Gray/
Primary Examiner
Art Unit 1794

jmg